

RESPONSE UNDER 37 C.F.R. § 1.111  
U.S. Appln. No. 09/982,749

**REMARKS**

Claims 1-33 have been examined. Claims 20-22 and 30-33 have been rejected under 35 U.S.C. § 101, and claims 1, 2, 9-11, and 18-20 have been rejected under 35 U.S.C. § 102(b).

**I. Rejection under 35 U.S.C. § 101**

Claims 20-22 and 30-33 have been rejected under 35 U.S.C. § 101 because they allegedly claim non-statutory subject matter. Specifically, the Examiner maintains that the claims merely define a device or manufacture that contains a data structure comprising a series of operations that could be, but are not necessarily, performed by a computer. Moreover, the Examiner contends that claims 20-22 and 30-33 recite a "disembodied storage device" (i.e., a memory) that stores a computer program as a "non-functional data structure." Applicants disagree and believe that the claims define statutory subject matter.

As background, M.P.E.P. § 2106(IV)(B)(1) recognizes two categories of software. The first category, known as "functional descriptive material," consists of "data structures and computer programs which impart functionality when employed as a computer component." (Id. at page 2100-11). The second category, known as "nonfunctional descriptive material" includes "music, literary works and a compilation or mere arrangement of data." (Id. at page 2100-12). Furthermore, M.P.E.P. § 2106(IV)(B)(1) expressly states:

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Both types of "descriptive material" [i.e., functional descriptive material and non-functional descriptive material] are nonstatutory when claimed as descriptive material *per se*. When functional descriptive material is recorded on some computer-readable medium it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized.

(*Id.* at page 2100-21 (emphasis added)). Furthermore, M.P.E.P. § 2106(IV)(B)(1)(a)

expressly states:

[A] claimed computer-readable medium encoded with a computer program is a computer element which defines structural and functional interrelationships between the computer program and the rest of the computer which permit the computer program's functionality to be realized, and is thus statutory.

(*Id.* at 2100-13 (emphasis added)).

**A. Claim 20**

Claim 20 recites a computer program, which comprises (1) a first program for causing a computer to receive an inquiry including expendable-related information by the computer, (2) a second program for causing the computer to determine a price based on the expendable-related information, and (3) a third program for causing the computer to display the price to the user. Clearly, the claim includes a computer program that imparts functionality when employed as a computer component, rather than software that relates to music, literary works, or a mere arrangement of data. Thus, Applicants submit that the computer program relates to "functional descriptive material" and not to "nonfunctional descriptive material."

Furthermore, claim 20 clearly states that the computer program is stored on the computer readable medium. Thus, as noted above, the claim defines statutory subject matter and satisfies

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the requirements of 35 U.S.C. § 101. (M.P.E.P. § 2106(IV)(B)(1) and M.P.E.P. § 2106(IV)(B)(1)(a)).

**B. Claims 21 and 22**

Since claims 21 and 22 depend upon claim 20, they incorporate all of the limitations of claim 20. Therefore, such claims recite patentable subject matter under 35 U.S.C. § 101 for the reasons presented above.

**C. Claim 30**

Applicants submit that claim 30 satisfies the requirements of 35 U.S.C. § 101 for the reasons that are similar to the reasons presented above in conjunction with claim 20.

**D. Claims 31-33**

Since claims 31-33 depend upon claim 30, they incorporate all of the limitations of claim 30. Therefore, such claims recite patentable subject matter under 35 U.S.C. § 101 for the reasons presented above.

**II. Rejection under 35 U.S.C. § 102(b) over U.S. Patent No. 5,383,129 to Farrell ("Farrell")**

Claims 1, 2, 9-11, and 18-20 have been rejected under 35 U.S.C. § 102(b) as being anticipated by Farrell. Applicants submit that the claims are patentable over the reference.

**A. Claim 1**

Claim 1 states that a computer receives an inquiry that includes expendable-related information and that such information is indicative of a model of an expendable container. On the other hand, Farrell does not disclose or suggest such features.

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On page 4 of the Office Action, the Examiner maintains that the reference describes a system that performs a print job and consumes expendable materials while performing the job. Furthermore, the Examiner seems to state that the expendable materials are removed from containers mounted in the system when the system performs the job.

However, Farrell does not suggest that a computer receives an inquiry that contains any type of information that is indicative of a model of an expendable container. Thus, Applicants submit that claim 1 is patentable over the reference.

**B. Claim 2**

Since claim 2 depends upon claim 1, Applicants submit that it is patentable at least by virtue of its dependency.

**C. Claim 9**

As a preliminary matter, Applicants disagree with the Examiner's contention that, in Farrell, the amount of new expendable materials injected into the container inherently has to equal the amount of expendable materials used in the print job. For Farrell to inherently disclose the above features, they "must be necessarily present and a person of ordinary skill in the art would recognize its presence." *Crown Operations International Ltd. v. Solutia Inc.*, 62 U.S.P.Q.2d 1917, 1923 (Fed. Cir. 2002). Inherency "may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient." *Id.*

In Farrell, the amount of new expendables placed into the container after a print job does not necessarily have to equal the amount of expendables used in the print job. For example, a paper container within the system may be able to store a maximum of 500 sheets of paper, but at

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the beginning of a print job, the container may only have 50 sheets of paper. In such a scenario, if a print job uses 50 sheets, the operator of the system will likely fill the paper container with 500 sheets of paper, rather than by filling the container with only 50 sheets. Otherwise, if the operator filled the container with only 50 sheets, he or she would have to fill the container much more frequently than if he or she filled the container to its maximum capacity each time the paper has to be replaced. Therefore, contrary to the Examiner's argument, Farrell does not inherently disclose, and actually teaches away from, replacing the expendable materials with an equal number of new expendables.

In addition, base claim 1 states that a price at which a new expendable is to be supplied is determined. Claim 9, which depends upon claim 1, states that the expendable is supplied by injecting the new expendable into the expendable container. Therefore, claim 9 states that the expendable that "is supplied" corresponds to the new expendable injected into the container. On the other hand, based on the Examiner's analysis of Farrell, the expendables that "are supplied" are the expendables used during the print job and not the new, replacement expendables placed into the containers after the print job is completed.

Accordingly, Applicants submit that claim 9 is patentable over Farrell. Also, since claim 9 depends upon claim 1, Applicants submit that it is patentable at least by virtue of its dependency.

**D. Claim 10**

Since claim 10 depends upon claim 1, Applicants submit that it is patentable at least by virtue of its dependency.

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**E. Claims 11 and 18**

Since claims 11 and 18 contain features that are analogous to the features discussed above in conjunction with claims 1 and 9, respectively, Applicants submit that they are patentable for analogous reasons.

**F. Claim 19**

Since claim 19 depends upon claim 11, Applicants submit that it is patentable at least by virtue of its dependency.

**G. Claim 20**

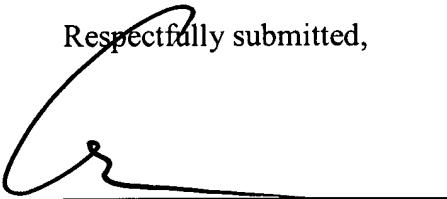
Since claim 20 contains features that are analogous to the features discussed above in conjunction with claim 1, Applicants submit that it is patentable for analogous reasons.

**III. Conclusion**

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

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Respectfully submitted,

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WASHINGTON OFFICE  
**23373**  
CUSTOMER NUMBER

Date: June 29, 2005